

Remarks

Claims 13-17 are pending in the application. Claims 1-12 have been cancelled from the application without prejudice or disclaimer of their subject matter. The new claims are supported by the specification. For example, the original claims and page 30, lines 25-27. No new matter has been added.

Double Patenting Rejections

Claims 1-12 were rejected under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent Nos. 5,667,969, 5,869,254, and 6,897,016. Claims 1-12 have been cancelled, rendering the rejection moot. Applicants request that the rejection be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-4 and 6-12 were rejected under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification is not enabling the use of ribozymes *in vivo* in whole organisms. While applicants do not concede the merits of this rejection, they thank the Examiner for recognizing that the specification does enable making and using the ribozymes *in vitro* or in cell culture. New independent claim 13 is directed to a method in cell culture. Accordingly, Applicants request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Haseloff et al. (WO 92/13090). Applicants respectfully submit that with the cancellation of these claims, this rejection is now moot. With respect to the new claims, Haseloff fails to describe the alteration of a deleterious molecule within a cell to a non-deleterious molecule. Rather Haseloff focuses on using the trans-splicing reaction to cause cell death, in particular by expressing molecules such as toxins. Thus, Applicants believe Haseloff is not relevant to the presently pending claims and, therefore, Applicants request that the rejection be withdrawn .

Rejections under 35 U.S.C. § 103

Cancelled claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Haseloff as applied to cancelled claims 1-9, 11 and 12 and further in view of Weber et al. (J. Gen. Virol. (1992) 73,2955-2961). Applicants respectfully submit that, with the cancellation of claim 10, this rejection is now moot. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Conclusion

With the above amendments and remarks, the Applicants submit that the application is in a condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite prosecution, the Examiner is encouraged to contact Applicants' undersigned representative.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff



Patrick Gattari

Registration No. 39,682

300 South Wacker Drive, 32nd Floor
Chicago, IL 60606
Facsimile: 312-913-0002
Telephone: 312-913-0001